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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/876,535	06/06/2001	Jun Shan Wey	004524.P030	7583

7590 01/15/2004

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EXAMINER

DUVERNE, JEAN F

ART UNIT

PAPER NUMBER

2839

DATE MAILED: 01/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/876,535

Applicant(s)

WEY ET AL.

Examiner

Jean F. Duverne

Art Unit

2839

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 14 October 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Giaretta et al (US patent US006510265B1) in view of Bristow et al (US patent US005892866A).

In regard to claim 1, Giaretta's device discloses a mode scrambler (see figs 2 and 4-5) comprising a first and second end wherein a single mode optical fiber on xy (see fig.2) coupled to the first end and a multi-mode optical fiber at 200 coupled to the second end, a gap (see fig. 2: discontinuity). However, Giaretta's device fails to disclose a diffuser in the gap. Bistow's device discloses a diffuser (37) in the gap between the fibers. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to add the diffuser in the gap such as the one taught in Bistow's for diffracting the single into multiple modes structure for improving the signal transmission in Giaretta's device.

In regard to claim 9, Giaretta's and Bistow's devices disclose the aforementioned limitations except for the method to scramble an optical signal. Nevertheless, the features recited in the method claims are identical to the limitations in

the apparatus claims mentioned above: the method to scramble an optical signal is not germane to the issue of patentability of the device itself. It is considered as inherent features. Therefore, this limitation has not been given any patentable weight.

In regard to claims 2-8, Giaretta's and Bristrow's devices disclose the aforementioned limitations but fail to explicitly disclose the material of which the diffuse is made of. It would have obvious to one having ordinary skill in the art at the time the invention was made to use the diffuser made with different type of materials, since it has held to be within the general skill of a worker in the art to select known material on the basis of its suitability for the intended use as a matter to meet system design and requirement. In re Leshin, 125 USPQ 416. It would have obvious to one having ordinary skill in the art at the time the invention was made to use the diffuser made with different type of materials to meet the system design and requirement.

In regard to claims 10-16, Giaretta's and Bristrow's devices disclose the aforementioned limitations except for the method to scramble an optical signal. Nevertheless, the features recited in the method claims are identical to the limitations in the apparatus claims mentioned above: the method to scramble an optical signal is not germane to the issue of patentability of the device itself. It is considered as inherent features. Therefore, this limitation has not been given any patentable weight.

### **Response to argument**

Applicant's arguments filed 11/6/2003 have been fully considered but they are not persuasive. The claims do not define "structural structure features" that distinguish

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over prior art: For example, both Giarretta's and Bristrow's devices disclose the mode scrambler features except for diffuser disclosed in Bristrow's device. Therefore, Bristrow's device discloses that adding a diffuser an optical mode scrambler is well-known in the art. Furthermore, in response to applicant's argument that there is no suggestion to combine the references or the prima facie case of obviousness, the examiner recognizes that references can not arbitrarily combined and that there must be some reason why one skilled in the art would be motivated to make the proposed combination of the primary and secondary references. In re Nomiya, 184 USPQ 607 (CCPA 1975). However, there is no requirement that a motivation to make the modification must be expressly articulated. The test for combining references is what the combination of the disclosure taken as a whole would suggest to one skilled in the art. In re McLaughlin, 170 USPQ 209 (CCPA 1971); references are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. In re Bozek, 163 USPQ 545 (CCPA 1969).

Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

***Conclusion***

**Any response to this action may be mailed to:  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450**

For additional information regarding this new address, which was effective May 1, 2003, see *Correspondence with the United States Patent and Trademark Office*, 68 Fed. Reg. 14332 (March 25, 2003).

**Or Faxed to:**  
(703) 872-9306.

**Hand-delivered responses** should be brought to:  
Crystal Plaza 4, Fourth Floor (Receptionist)  
2201 South Clark Place, Arlington, Virginia.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jean F. Duverne whose telephone number is (703) 305-0297. The examiner can normally be reached on 9:00-7:30, Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynn Feild can be reached on (703) 308-2710. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

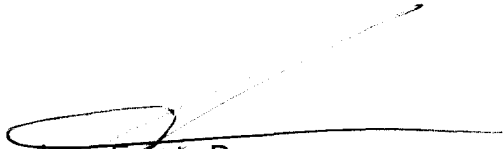
Any inquiry of a general nature or relating to the status of this application or

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proceeding should be directed to the receptionist whose telephone number is  
(703) 308-0956.

JFD

1/11/2004



Jean-Franz Duverne  
Primary Examiner  
Art Unit 2839